

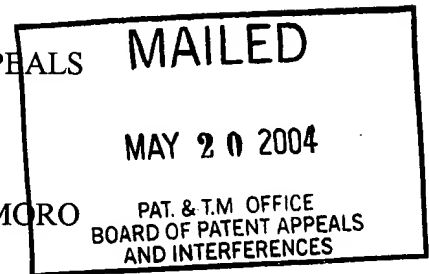
The opinion in support of the decision being entered today was **not** written
for publication and is **not** binding precedent of the Board.

Paper No. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte AKIHIRO GOTO and TOSHIO MORO



Appeal No. 2003-1943
Application No. 09/937,220

HEARD: FEBRUARY 19, 2004

Before PAK, JEFFREY T. SMITH, and PAWLIKOWSKI, Administrative Patent Judges.
PAK, Administrative Patent Judge.

REMAND TO THE EXAMINER

This case is not ripe for meaningful review and is, therefore, remanded to the examiner again
for appropriate action consistent with the views expressed below.

The initial inquiry into determining the propriety of the examiner's rejection is to correctly
construe the scope of the claimed subject matter. *See, e.g., In re Paulsen*, 30 F.3d 1475, 1479, 31
USPQ2d 1671, 1674 (Fed. Cir. 1994). If no reasonable definite meaning can be ascribed to terms

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appearing in the claims on appeal, the claimed subject matter does not become unpatentable over prior art, but becomes indefinite under Section 112, second paragraph. *In re Steele*, 305 F.2d 859, 862-63, 134 USPQ 292, 295 (CCPA 1962).

In the Answer, however, the examiner did not define the scope of the means-plus-function limitation recited in the claims on appeal, nor did the examiner's rejection address such limitation. Thus, we remanded the application to the examiner to determine:

- (1) Whether the means-plus-function limitation recited in the claims on appeal is indefinite within the meaning of 35 U.S.C. § 112, second paragraph;
- (2) What meaning, if definite, is attributed to the means-plus-function limitation in question; and
- (3) Whether any rejection based on Magara and/or any other prior art is appropriate based on this new interpretation.

We did not authorize the examiner to submit any Supplemental Answer under 37 CFR § 1.193(b)(1)(2002), thus allowing the examiner to reopen prosecution if any of the above rejections is appropriate. See the Remand Order entered March 16, 2004.

In response to our Remand Order, the examiner submitted an informal one-page response alleging, for the first time, that (1) the claimed means-plus-function limitation equal to a black box which in turn is equal to some known structure not disclosed in the specification and (2) based on this new interpretation, the examiner's rejection based on Magara is justified. This informal response by the examiner, however, is not in compliance with our Remand Order. If the examiner

wishes to issue any rejection, including that referred to in the informal response based on the new interpretation, the examiner's only option is to reopen the prosecution of this application.

Thus, we remand this application again to the examiner to comply with our previous Remand Order as indicated above. We wish to emphasize, however, that the examiner's informal determination that the black box illustrated in the application somehow corresponds to the purse switching circuit referred by the examiner is not shown to be supported by any evidence and/or law. The examiner is reminded to read the statements from *Atmel Corp. v. Information Storage Devices, Inc.*, 198 F.3d 1374, 1382, 53 USPQ2d 1225, 1230-31 (Fed. Cir. 1999), which are shown below for the examiner's convenience:

[I]n order for a claim to meet the particularity requirement of ¶ 2, **the corresponding structure(s) of a mean-plus-function limitation must be disclosed** in the written description in such a manner that one of ordinary skill in the art will know and understand what structure corresponding to the means limitation. Otherwise, one does not know what the claim means....

Section 112, ¶ 6, however, does not have the expansive purpose of ¶ 1. It sets forth a simple requirement, *a quid pro quo*, in order to utilize a generic means expression. All one needs to do in order to obtain the benefit of that claiming device is to [disclose] **some structure** corresponding to the [claimed] means..., as the statute states, so that one can readily ascertain what the claim means and comply with the particularity requirement of ¶ 2. The requirement of specific structure in § 112, ¶ 6 thus does not raise the specter of an unending disclosure ... If our interpretation of the statute results in **a slight amount of additional written description appearing in patent specifications compared with total omission of structure**, that is the trade-off necessitated by an applicant's use of the statute's permissive generic means term. (Emphasis added.)

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We remand this application to the examiner via the Office of a Director of the Technology Center for appropriate action in view of the above instruction.

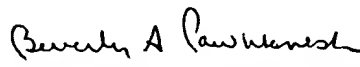
This application, by virtue of its "special" status, requires immediate action. See *MPEP* § 708.01 (8th Ed., Aug. 2001). It is important that the Board be informed promptly of any action affecting the appeal in this application.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

REMANDED


CHUNG K. PAK
Administrative Patent Judge


JEFFREY T. SMITH
Administrative Patent Judge


BEVERLY A. PAWLIKOWSKI
Administrative Patent Judge

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The claim is considered to be proper under 35 USC 112, 2nd paragraph because one of ordinary skill in the art, reading the claim language, would understand the structure from the specification corresponding to the means plus function language. For example, at page 9, lines 2-15 and more specifically in the detailed description at page 12, line 12 - page 14, line 19 the structure of the control means is described in terms typical in this art. Although, the application refers to a black box (i.e. "control means"), in Figure 1A, resistors (16) in conjunction with elements 13 are turned on and off by controller 14. One in the art would recognize that "control means:" 14 is merely part of the overall control means which provide the claimed function.

The reference is considered to show substantially the same structure as described in the instant specification (i.e. see Figure 14, controller with resistors, switches, etc...). Additionally, the same function is performed by both means of the instant specification and the reference (i.e. controller with switches and resistors divide the pulse).

In summary, the structure of the "control means" is implicitly shown in both the instant specification and the prior art to be a pulse switching circuit. Because these pulse switching circuits are so well known to those in the art, they are typically shown as black boxes, for example as a box labeled "controller" (14) in Magara et al. (U.S. Pat. no. 5,434,380).